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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/914,543

01/17/2002

David E. Lam

7769

25225 7590 01/17/2008  
MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

EXAMINER

RAGHU, GANAPATHIRAM

ART UNIT

PAPER NUMBER

1652

MAIL DATE

DELIVERY MODE

01/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/914,543

**Applicant(s)**

LAM ET AL.

**Examiner**

Ganapathirama Raghu

**Art Unit**

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,14-16,19,20,23-27,31,37-39,44,45 and 60-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-9,14-16,19,20,24-26,29,31,37-39,53-55,63,64 and 68-71 is/are allowed.
- 6) ☒ Claim(s) 45-52,65-67 and 72-80 is/are rejected.
- 7) ☒ Claim(s) 23,27,,44,49-51,60-62 and 72 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Application Status***

Please note that the instant application/case has been transferred to examiner Ganapathirama Raghu, Art Unit 1652, whose telephone number is (571)-272-4533 and all further enquiries regarding this application should be directed to said examiner.

In response to the Office Action mailed on 06/22/2007, applicants' filed a response on 11/20/2007. Said response, canceled claims 18, 22, 32, 35 and 36 and added new claims 75-80. Thus claims 1, 2, 4-9, 14-16, 19, 20, 23-27, 29, 31, 37-39, 44-55 and 60-80 are pending in this application and are under consideration. However, examiner notes that amended claim set is replete with grammatical errors and needs clarification and correction.

Objections and rejections not reiterated from previous action are hereby withdrawn.

***Objections to Abstract***

The abstract of the disclosure is objected to because, Abstract should be on a separate sheet of paper. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

Claim 60 and claims 44, 49-51, 61, 62 and 72 depending therefrom are objected to because of the following informalities:

Applicant is advised that should claim 27 be found allowable, claim 60 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 23 is objected to as it depends from a canceled claim, claim 22.

Claims 49 and 65 are objected to because of the following informalities: Claims as written do not make clear scientific sense. How can a protein be contained in a textile?

***Claim Rejections: 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49-52, 65-67 and 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 50-52, 66, 67 and 73 as written does not convey clear meaning as to whether claims recite a protein or a composition comprising the protein. Examiner construes the meaning of the claims (composition) to convey the following:

Claim 49, ...A composition for treating textile comprising the polypeptide of... (also see claim objection above).

Claim 50, A feed composition comprising the polypeptide...

Claim 51, A detergent composition comprising the polypeptide...

Claim 52, A juice or a brew composition comprising the polypeptide...

Claim 65, ...A composition for treating textile comprising the polypeptide of... (also see claim objection above).

Claim 66, ...A feed composition comprising the polypeptide of...

Claim 67 ...A detergent composition comprising the polypeptide of...

Claim 73, ...A juice composition comprising the polypeptide of...

Examiner suggests changing the language of the claims to recite said claims are drawn to a composition. Clarification and appropriate correction is required.

Claims 72 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of the claims are not clear. Examiner needs clarification regarding what is encompassed in a Biomass? plants, animals, micro-organisms or all living matter and how is the polypeptide contained in them? Furthermore it is not clear if these claims recite the protein or a biomass comprising the protein. Said claims need to be cancelled or reworded to convey the exact meaning. Clarification and appropriate correction is required.

Claims 45-48 and 75-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 45-48 and 75-80 recite the phrase "in a, or with, a" and is confusing as contacting with the polypeptide with detergent or textile or animal feed or waste or juice or a brew does not make sense. The claims as written does not convey clear grammatical meaning or scientific sense. Clarification and correction is required.

***New-Matter Claim Rejections: 35 USC § 112***

Amended claims 45-48 and 75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claims 45-48 and 75 are rejected because the phrase "... contacting

a carboxymethylcellulose” is new matter. The scope of “contacting a carboxymethylcellulose” as claimed was not contemplated in the specification as originally filed. The method disclosed in the original specification has a different scope than the method now claimed. The specification as originally filed discloses an endoglucanase enzyme having carboxymethylcellulase activity and utilizing said enzyme in a method for degradation of cellulose as a substrate, whereas carboxymethylcellulose is an artificial substrate.

### ***Summary of Pending Issues***

The following is a summary of issues pending in the instant application.

- 1) Claim 60 and claims 44, 49-51, 61, 62 and 72 depending therefrom are objected to due to the following informalities: Claim 60 is a substantial duplicate of claim 27.
- 2) Claim 23 is objected to as it depends from a canceled claim, claim 22.
- 3) Claim 49 and 65 are objected to because of the following informalities: Claims as written does not make clear scientific sense.
- 4) Claims 45-52, 65-67 and 72-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 5) Amended claims 45-48 and 75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement (new-matter).
- 6) Claims 1, 2, 4-9, 14-16, 19, 20, 24-26, 29, 31, 37-39, 53-55, 63, 64 and 68-71 are allowed.

Applicants must respond to the objections/rejections in each of the sections in this Office Action to be fully responsive for prosecution.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### ***Final Comments***

To insure that each document is properly filed in the electronic file wrapper, it is requested that each of amendments to the specification, amendments to the claims, Applicants' remarks, requests for extension of time, and any other distinct papers be submitted on separate pages.

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It is also requested that Applicants identify support, within the original application, for any amendments to the claims and specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ganapathirama Raghu whose telephone number is 571-272-4533. The examiner can normally be reached between 8 am-4: 30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of the application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ganapathirama Raghu, Ph.D.  
Patent Examiner  
Art Unit 1652  
Jan. 11, 2007.

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